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EXAMINER
SALTARELLI, DOMINIC D

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

	Application No.	Applicant(s)
Office Action Summary	09/585,263	GORDON ET AL.
	Examiner	Art Unit	
	DOMINIC D. SALTARELLI	2421	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>13 February 2009</u>.

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1,5,7-10,13 and 14</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1,5,7-10,13 and 14</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

        1. ☐ Certified copies of the priority documents have been received.

        2. ☐ Certified copies of the priority documents have been received in Application No. _____.

        3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1.   Applicant's arguments filed February 13, 2009 have been fully considered but they are not persuasive.

       First, the references cited in reopening prosecution are largely the result of the examiner's own years of experience in examining applications in the current art. A search was necessitated insofar as to let the examiner locate and identify the specific patent numbers associated with the art with which the examiner has prior knowledge of which renders the claimed invention obvious.

       Second, applicant argues that Hendricks fails to disclose the transmission of the bitmap for the channel information window is performed via an out-of-band channel, stating that the cited section, which states using a separate channel exclusively for menu information, is somehow entirely dissimilar from the claimed limitation (applicant's remarks, page 9).

       In response, it is unclear how the applicant is attempting to define and out-of-band channel in this case. The conventional use of the term "out-of-band channel" is a frequency band reserved for carrying a particular type of service, control, or maintenance related data over a network. When used in the television distribution environment, in practice, out-of-band channels are reserved frequencies used to carry non-programming or non-audio/visual content (known as "in-band" content). Hendricks' disclosure of using a dedicated channel for

menu data is consistent with the common usage of the term "out-of-band", and

there is no disclosure in applicant's originally filed specification which redefines

the term otherwise.

Third, applicant argues that the examiner claimed that Hendricks taught

sending bitmaps after saying he did not (applicant's remarks, page 9).

In response to applicant's arguments against the references individually,

one cannot show nonobviousness by attacking references individually where the

rejections are based on combinations of references. See *In re Keller*, 642

F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231

USPQ 375 (Fed. Cir. 1986). In this case, the examiner very clearly

demonstrated that the graphics being downloaded by Hendricks were in a bitmap

format when modified in view of Gordon.

Lastly, applicant argues that the stated rationale for modifying Hendricks

in view of Gordon does not meet the "teaching, suggestion, or motivation" test of

obviousness (applicant's remarks, page 9)

MPEP 2141 states:

"Although the Supreme Court in KSR cautioned against an overly rigid

application of TSM, it also recognized that TSM was one of a number of valid

rationales that could be used to determine obviousness… The Court in KSR

identified a number of rationales to support a conclusion of obviousness which

are consistent with the proper "functional approach" to the determination of obviousness as laid down in Graham. KSR, 550 U.S. at ___, 82 USPQ2d at 1395-97."

These other rationales include an element being "obvious to try" when there are only a finite number of predicable solutions that can be applied with a reasonable expectation of success. In this case, since Hendricks did not explicitly define what format his graphics would be delivered in, looking to the prior for a solution renders a finite number of formats for delivering graphics over a network, of which the use of bitmaps as taught by Gordon are one of the alternatives, and thus "obvious to try" as explained by the examiner.

Regarding claims 5, 7, 8, 9, 10, 13, and 14, these arguments are moot in view of the new grounds of rejection presented herein in view of Gordon, who also provides a separate teaching of "wherein elements on a display screen can be selectively masked and displayed".

Claim Rejections - 35 USC § 103

2.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3.   Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over

Hendricks, et al. (5,559,549, of record) [Hendricks] in view of Gordon et al. (6,208,335,

of record) [Gordon].

Regarding claim 1, Hendricks discloses a method comprising:

generating, at a head end, at least one graphic for a channel information

window (the STTCIS is generated at a head end [network controller 214, see fig.

3], col. 13, lines 28-40, and it is the STTCIS which includes the graphics files

which are stored in a set top and used to display program guide information, col.

13, lines 55-58; col. 18, lines 35-58; and col. 24, lines 7-41, see particularly col.

24, lines 31-41, which shows the local memory is written and rewritten with

graphics files from the information received from the head end);

encoding, at the head end, a broadcast video presentation and the graphic

for the channel information window (signal compression [for both the program

control information and the video signals] is performed by the head end, col. 6,

lines 27-38 and col. 9, lines 15-22), the broadcast video presentation being

programming from one of a plurality of channels (col. 6, lines 38-41);

transmitting, from the head end to a set top terminal, the broadcast video

presentation and the graphic for the channel information window (col. 8, lines 40-

44);

receiving at the set top terminal a signal to activate the channel

information window (col. 12, lines 10-22, wherein the signal to activate the

information window is a user initiation of the menu system, this includes the initial

menu screen associated with turning on the set top device, col. 12, lines 23-30, and active inputs from a user for viewing other menus, col. 12, lines 57-67);

decoding, at the set top terminal, the graphic for the channel information window (the graphics files are compressed upon storage in the set top, and are decompressed when it is time to assemble a menu, col. 14, lines 34-42 and col. 25, lines 57-61); and

compositing, at the set top terminal, the graphic for the channel information window and the broadcast video presentation to produce a video stream for a display (col. 18, lines 48-67) so that the channel information window overlays and obscures a portion of the broadcast video presentation on the display (col. 18, lines 11-27) wherein transmitting the graphic for the channel information window is performed via an out-of-band channel (col. 14, lines 5-6).

Hendricks fails to disclose the graphic is a bitmap and elements on a display screen can be selectively masked and displayed.

In an analogous art, Gordon teaches a system wherein downloaded graphics used in displaying overlays atop of video content are downloaded as bitmaps (col. 7, lines 7-40) and elements on a display screen can be selectively masked and displayed (such features disclosed as providing an enhancement to the display, col. 8, lines 8-22).

It would have been obvious at the time to a person of ordinary skill in the art to modify the method of Hendricks to download the graphics as bitmaps and elements on a display screen can be selectively masked and displayed, as

taught by Gordon. Hendricks lacks any teaching as far as what specific file

format the graphics are delivered to the receiver as, and it is thus up to the

person of ordinary skill in the art to then decide on a file format for graphics.

Gordon is evidence that it was quite well known in the art to use the bitmap

format for precisely the type of graphical objects described by Hendricks, and

would thus be an obvious choice to one of ordinary skill in the art. Further,

Gordon teaches that selectively masking and displaying elements on a display

screen provided an enhanced graphical display (i.e. more entertaining or

engaging).

4.   Claims 5 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Hendricks in view of Gordon and Miller et al. (5,585,866, of record) [Miller].

        Regarding claim 5, Hendricks discloses a method comprising:

        generating, at a head end, a plurality of graphics for each of a plurality of

channel information windows (the STTCIS is generated at a head end [network

controller 214, see fig. 3], col. 13, lines 28-40, and it is the STTCIS which

includes the graphics files which are stored in a set top and used to display

program guide information, col. 13, lines 55-58; col. 18, lines 35-58; and col. 24,

lines 7-41, see particularly col. 24, lines 31-41, which shows the local memory is

written and rewritten with graphics files from the information received from the

head end);

encoding, at the head end, a plurality of broadcast video displays and the
channel information windows (signal compression [for both the program control
information and the video signals] is performed by the head end, col. 6, lines 27-
38 and col. 9, lines 15-22), the broadcast video displays including a particular
broadcast video display, each broadcast video display being programming from
one of a plurality channels (col. 6, lines 38-41), the channel information windows
including information about the channels (downloaded graphic elements include
specific logos associated with particular channels, col. 24, lines 20-30);

transmitting, from the head end to the set top terminal, the broadcast
video displays and the channel information windows (col. 8, lines 40-44); and

compositing, at the set top terminal, the particular broadcast video display
and an associated one of the channel information windows to produce a video
stream for a display (col. 18, lines 48-67) so that the channel information window
overlays and obscures a portion of the particular broadcast video display (col. 18,
lines 11-27).

Hendricks fails to disclose the graphics are bitmaps, elements on a display
screen can be selectively masked and displayed, and changing, at the set top
terminal, the channel information window in response to a navigation command,
while the particular broadcast video display remains the same.

In an analogous art, Gordon teaches a system wherein downloaded
graphics used in displaying overlays atop of video content are downloaded as
bitmaps (col. 7, lines 7-40), and elements on a display screen can be selectively

masked and displayed (such features disclosed as providing an enhancement to the display, col. 8, lines 8-22).

It would have been obvious at the time to a person of ordinary skill in the art to modify the method of Hendricks to download the graphics as bitmaps and elements on a display screen can be selectively masked and displayed, as taught by Gordon. Hendricks lacks any teaching as far as what specific file format the graphics are delivered to the receiver as, and it is thus up to the person of ordinary skill in the art to then decide on a file format for graphics. Gordon is evidence that it was quite well known in the art to use the bitmap format for precisely the type of graphical objects described by Hendricks, and would thus be an obvious choice to one of ordinary skill in the art. Further, Gordon teaches that selectively masking and displaying elements on a display screen provided an enhanced graphical display (i.e. more entertaining or engaging).

Hendricks and Gordon fail to disclose changing, at the set top terminal, the channel information window in response to a navigation command; while the particular broadcast video display remains the same.

In an analogous art, Miller teaches a channel information window overlay atop an ongoing video presentation, wherein the contents of the overlay are changed in response to a navigation command while the particular broadcast video remains the same (col. 13, lines 16-64), for the benefit of allowing a user to

both enjoy a particular video program while also viewing programming

information for other programs (col. 13, lines 16-20 and lines 45-48).

It would have been obvious at the time to a person of ordinary skill in the

art to modify the method of Hendricks and Gordon to include changing, at the set

top terminal, the channel information window in response to a navigation

command, while the particular broadcast video display remains the same, as

taught by Miller, for the benefit of allowing a user to both enjoy a particular video

program while also viewing programming information for other programs.

Regarding claim 8, Hendricks, Gordon, and Miller disclose the method of

claim 5, wherein the navigation command in that mode navigates only through

favorite channels (Miller, col. 26, lines 54-67).

5.   Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over

Hendricks, Gordon, and Miller as applied to claim 5 above, and further in view of Hoarty

(5,485,197, of record).

Regarding claim 7, Hendricks, Gordon, and Miller disclose the method of

claim 5, including changing the particular broadcast video display to a new

broadcast video display upon termination of the navigation command in that

mode (Miller, col. 13, lines 55-61), but fail to disclose changing the particular

broadcast video display is accomplished by generating, encoding, and

transmitting video packet streams at the head end

In an analogous art, Hoarty teaches a video distribution system (fig. 3) wherein changing a particular broadcast video display is accomplished by generating, encoding, and transmitting video packet streams at the head end (col. 7, lines 35-65, col. 8, lines 40-49, and col. 12, lines 15-32, wherein a particular user is allocated a particular frequency channel in order to access a very wide range of services, and a channel change command changes the content supplied on the "virtual" channel), providing a wider range of services to users than would otherwise be available.

It would have been obvious at the time to a person or ordinary skill in the art to modify the method disclosed by Hendricks, Gordon, and Miller to include said changing of the particular broadcast video display is accomplished by generating, encoding, and transmitting video packet streams at the head end, as taught by Hoarty, for the benefit of providing a wider range of services to users than would be possible given the finite amount of available bandwidth over a distribution medium.

6.   Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hendricks in view of Gordon and Bolanos et al. (5,793,364, of record) [Bolanos].

Regarding claims 9 and 10, Hendricks discloses a method comprising:

generating, at a head end, a broadcast video presentation and graphics for a channel information window (the STTCIS is generated at a head end [network controller 214, see fig. 3] along with video content, col. 13, lines 28-40,

and it is the STTCIS which includes the graphics files which are stored in a set top and used to display program guide information, col. 13, lines 55-58; col. 18, lines 35-58; and col. 24, lines 7-41, see particularly col. 24, lines 31-41, which shows the local memory is written and rewritten with graphics files from the information received from the head end), the broadcast video presentation being programming from one of a plurality of channels (col. 6, lines 38-41);

encoding, at the head end, the broadcast video presentation and the graphic for the channel information window (signal compression [for both the program control information and the video signals] is performed by the head end, col. 6, lines 27-38 and col. 9, lines 15-22);

transmitting, from the head end to a set top terminal, the broadcast video presentation and the graphic for the channel information window (col. 8, lines 40-44);

decoding, at the set top terminal, the graphic for the channel information window (the graphics files are compressed upon storage in the set top, and are decompressed when it is time to assemble a menu, col. 14, lines 34-42 and col. 25, lines 57-61); and

compositing, at the terminal, the graphic for the channel information window and the broadcast video presentation to produce a video stream for a display (col. 18, lines 48-67) so that the channel information window overlays and obscures a portion of the particular broadcast video display (col. 18, lines 11-27).

Hendricks fails to disclose the graphics are bitmaps, wherein elements on a display screen can be selectively masked and displayed, and receiving at the head end from the terminal, a signal to active the channel information window.

In an analogous art, Gordon teaches a system wherein downloaded graphics used in displaying overlays atop of video content are downloaded as bitmaps (col. 7, lines 7-40), and elements on a display screen can be selectively masked and displayed (such features disclosed as providing an enhancement to the display, col. 8, lines 8-22).

It would have been obvious at the time to a person of ordinary skill in the art to modify the method of Hendricks to download the graphics as bitmaps and elements on a display screen can be selectively masked and displayed, as taught by Gordon. Hendricks lacks any teaching as far as what specific file format the graphics are delivered to the receiver as, and it is thus up to the person of ordinary skill in the art to then decide on a file format for graphics. Gordon is evidence that it was quite well known in the art to use the bitmap format for precisely the type of graphical objects described by Hendricks, and would thus be an obvious choice to one of ordinary skill in the art. Further, Gordon teaches that selectively masking and displaying elements on a display screen provided an enhanced graphical display (i.e. more entertaining or engaging).

Hendricks and Gordon fail to disclose receiving at the head end from the terminal, a signal to active the channel information window.

In an analogous art, Bolanos teaches downloading graphics for a user interface on demand (col. 3, lines 24-32), for the benefit of not having to repeatedly transmit the user interface graphics.

It would have been obvious at the time to a person of ordinary skill in the art to modify the method disclosed by Hendricks and Gordon to include downloading graphics for the user interface on demand [in response to an activation signal], as taught by Bolanos, for the benefit of not having to repeatedly transmit the channel information window bitmap.

7.   Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hendricks and Gordon as applied to claim 1 above, and further in view of Bolanos.

Regarding claim 13, Hendricks and Gordon disclose the method of claim 1, but fails to disclose requesting, by the set top terminal from the head end, the bitmap for the channel information window in response to the signal to activate the channel information window.

In an analogous art, Bolanos teaches downloading graphics for a user interface on demand (col. 3, lines 24-32), for the benefit of not having to repeatedly transmit the user interface graphics.

It would have been obvious at the time to a person of ordinary skill in the art to modify the method disclosed by Hendricks and Gordon to include downloading the graphics for the user interface on demand, as taught by

Bolanos, for the benefit of not having to repeatedly transmit the channel information window bitmap.

8.   Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hendricks and Gordon as applied to claim 1 above, and further in view of MacInnis (5,951,639, of record).

Regarding claim 14, Hendricks and Gordon disclose the method of claim 1, wherein the set top terminal causes the channel information window to overlay the broadcast video presentation in response to the signal to activate the channel activation window (col. 18, lines 11-27) but fails to disclose the bitmap for the channel information window is broadcast continually.

In an analogous art, MacInnis teaches a method for downloading data wherein the data is broadcast continually (col. 4, lines 20-41), for the benefit of alleviating the need to request the data from a source (col. 4, lines 38-41).

It would have been obvious at the time to a person of ordinary skill in the art to modify the method disclosed by Hendricks and Gordong to include broadcasting the data continually, as taught by MacInnis, for the benefit of alleviating any possible need to request the channel information window from the head end.

Conclusion

9.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to DOMINIC D. SALTARELLI whose telephone number is

(571)272-7302. The examiner can normally be reached on Monday - Friday 9:00am -

6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

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Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dominic D Saltarelli/
Primary Examiner, Art Unit 2421